

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

WAGNER, ET AL.

Serial No.: 09/113,446

Filed: 07/10/1998

For: **HOUSING FOR PORTABLE
HANDHELD ELECTRONIC DEVICE**

Art Unit: 3624

Examiner: G. ANDERSON

#12
M 3
9/17/01

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REPLY BRIEF

Honorable Commissioner
for Patents
Washington, D.C. 20231

Attention: Board of Patent Appeals and Interferences

This is in reply to the Examiner's answer dated July 5, 2001.

As a preliminary matter, the Examiner's assertion that claims 6-11 stand or fall together is incorrect. 37 C.F.R. 1.192(c)(7) provides that the claims are grouped in accordance with the grounds of rejection. Claims within each group stand or fall together unless a statement is included to the contrary. However, there is nothing in the rule to suggest that the Examiner's grouping of the claims should be ignored and that all claims on appeal should stand or fall together.

As the Examiner acknowledges in his answer, three grounds for rejection are asserted. Claims 6-8 are rejected under 35 U.S.C. § 102(b) based on Schmidt; claims 9-10 are rejected under 35 U.S.C. § 103(a) based on Schmidt in combination with Matone; and claim 11 is rejected under 35 U.S.C. § 103(a) based on Schmidt in combination with Mottmiller. Each ground of rejection must be separately decided based upon a single claim from the group.

NOTED

Turning to the substance of the Examiner's Answer, Applicant maintains, with respect to claims 6-8, that the Schmidt reference fails to disclose "a one-piece, hollow body portion" as required by independent claim 6. Since Schmidt fails to disclose each and every element of the claimed invention, the rejection under 35 U.S.C. § 102(e) cannot be sustained.

The Examiner argues that: "Schmidt discloses upper and lower body parts which when secured to each other make the body portion. One could therefore say that the body portion of Schmidt is one piece of the scanner." By the Examiner's own admission, the body portion of Schmidt's scanner is made of at least two pieces. Clearly, this is not a "one-piece, hollow body portion" as recited in claim 6. One need only refer to the dictionary definition of "one-piece" cited in Applicant's Appeal Brief, i.e., "consisting of or made in a single undivided piece". Moreover, the specification of the subject application provides further definition of the meaning of "one-piece". As set forth in Applicant's Appeal Brief, page 4, lines 10-12 of the specification states that: "body portion 12 is made as a single part rather than as two joined halves. This eliminates the need for bonding or otherwise joining two halves and also eliminates the presence of an unattractive seam line."(emphasis added) This clearly distinguishes the claimed invention over the disclosure of Schmidt. As mentioned above, the Examiner expressly acknowledges that the body portion of Schmidt's scanner is made of upper and lower parts (i.e., two pieces) that are secured to each other. Since Schmidt does not disclose a "one-piece, hollow body portion" as such term is used in the claims on appeal, the rejection of claims 6-8 under 35 U.S.C. § 102(b) is improper and should be reversed.

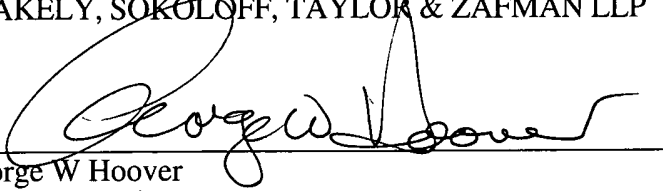
Applicants' arguments with respect to claim group 2 (claims 9-10) and claim group 3 (claim 11) are not addressed in the Examiner's answer. For the reasons presented in the Appeal Brief, Applicant submits that the rejections of these claims under 35 U.S.C. § 103(a) are also improper and should be reversed.

Based on the record in this case, Applicant submits that all of claims 6-11 define patentable subject matter and respectfully requests that the Examiner's final rejection of these claims be reversed.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP


Dated: September 5, 2001


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Azar Burnham
September 5, 2001
Date

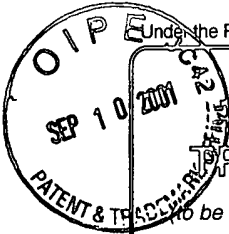
3624

PTO/SB/21(08/00)

Approved for use through 19/30/2000. OMB 0651-0031

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TRANSMITTAL FORM <small>Do not be used for all correspondence after initial filing</small>		Applicati n Numb r	09/113,446
		Filing Date	July 10, 1998
		First Named Inventor	Gregg Wagner
		Group Art Unit	3624
		Examiner Name	G. Anderson
Total Number of Pages in This Submission	13	Attorney Docket Number	3470P005

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	George W Hoover, Reg. No. 32,992 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
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Date	September 5, 2001

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FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$) 0.00

Complete if Known

Application Number	09/113,446
Filing Date	07/10/98
First Named Inventor	Gregg Wagner, et al.
Examiner Name	G. Anderson
Group Art Unit	3624
Attorney Docket Number	3470P005

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Blakely, Sokoloff, Taylor & Zafman LLP

- ☒ Charge Any Additional Fee Required
Under 37CFR 1.16 and 1.17

- ☐ Applicant claims small entity status.
See 37 CFR 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Money Order ☐ Other

FEE CALCULATION

1. FILING FEE

Large Code	Entity Fee (\$)	Small Code	Entity Fee (\$)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	

SUBTOTAL (1) (\$)

2. CLAIMS

Total Claims	Extra	Fee from below	Fee Paid
Independent Claims		X	
		X	

Multiple Dependent Claims

Large Code	Entity Fee (\$)	Small Code	Entity Fee (\$)	Fee Description	Fee Paid
103	18	203	9	Claims in excess of 20	
102	80	202	40	Independent claims in excess of 3	
104	270	204	135	Multiple Dependent claim	
109	80	209	40	Reissue independent claims over original patent	
110	18	210	9	Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$)

*or number previously paid, if greater, For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEE

Large Code	Entity Fee (\$)	Small Code	Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920	112	920	Requesting publication of SIR prior to Examiner action	
113	1,840	113	1,840	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for response within first month	
116	390	216	195	Extension for response within second month	
117	890	217	445	Extension for response within third month	
118	1,390	218	695	Extension for response within fourth month	
128	1,890	228	945	Extension for response within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidably	
141	1,240	241	620	Petition to revive - unintentionally	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) Reply brief

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* Reduced by Basic Filing Fee Paid

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George W Hoover

Date

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